

REMARKS

I. INTRODUCTION

In response to the Office Action dated August 5, 2005, and the Advisory Action dated October 21, 2005, claims 8, 13-17, 20-32 and 37-38 have been canceled. Claims 9, 10, 18 and 36 have been amended. Claims 7, 9-12, 18-19, and 33-36 remain in the application. Of these pending claims, claims 18, 19, 34 and 36 were previously withdrawn as drawn to a non-elected invention. Entry of these amendments, and reconsideration of the application, as amended, is requested.

II. CLAIM AMENDMENTS

Applicants' attorney has made amendments to the claims as indicated above. These amendments were made solely for the purpose of clarifying the language of the claims, and do not introduce new matter or raise new issues. Entry of these amendments is respectfully requested.

Claim 9 has been amended to clarify the recitation of the polypeptide as consisting of amino acids 475-483 of SEQ ID NO: 9.

Claim 10 has been amended to clarify that the fusion protein requires fusion of the HSV polypeptide to an unrelated immunogenic fusion protein, as stated in the specification in the first sentence of paragraph 0071.

Claim 18 has been amended to incorporate the limitations of canceled claim 13, from which it previously depended, and to limit the features to recite the same scope of HSV molecules as is recited in the polypeptide composition claims.

Claim 36 has been amended to clarify its language in a manner that parallels the other claims directed to a method of treating an HSV infection.

III. ALLOWABLE SUBJECT MATTER

On page (4) of the Office Action, claims 7, 12, 33, and 35 were indicated as allowable over prior art Dilella et al. (Dilella). In addition, claim 9 was indicated as allowable in the Advisory Action dated October 21, 2005. Applicants appreciate the Examiner's acknowledgement of allowable subject matter, and have amended the remaining claims to be consistent with the identified

subject matter, the comments on the continuation sheet of the Advisory Action, and a brief telephonic communication between Karen Canady and Examiner Salimi on November 3, 2005.

IV. RESTRICTION REQUIREMENT

On page (2) of the Office Action, it was noted that claims 13-32, 34 and 36-38 have been withdrawn from consideration, as they are directed to distinct group(s). Applicants have canceled claim 13-17, 20-32 and 37-38. With regard to the remaining claims, however, Applicants respectfully request the Examiner consider rejoinder of these claims in view of the amendments to these claims. Claims 18 and 36 have been amended to be consistent in scope and content with the subject matter of claims identified as allowable and in a manner that requires no further search or examination effort on the part of the Patent and Trademark Office.

V. PRIOR ART REJECTIONS

On pages (2) and (3) of the Office Action, claims 8-11 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Dilella, PCT Application No. WO 95/06055. Applicants respectfully traverse these rejections.

A. Claim 8

Independent claim 8 is directed to an HSV polypeptide consisting of amino acids 404-627 of UL26 (SEQ ID NO: 9). The cited reference does not teach nor suggest this particular polypeptide. The Examiner takes the position that it would have been obvious to one of ordinary skill in the art to find a 200 amino acid fragment of UL26 of HSV that induces an immune response, absent any unexpected results. Claim 8, however, is directed to a particular region of UL26, amino acids 404-627 of SEQ ID NO: 9. Dilella does not teach or suggest this particular region of UL26. Moreover, it would not be obvious to one of skill in the art to select amino acids 404-627 of UL26, in particular, as a candidate for use as an immunogenic polypeptide, nor would one skilled in the art consider it obvious that amino acids 404-627, in particular, would be successfully used as an immunogen.

Although Applicants maintain that the selection of amino acids 404-627 is not taught or suggested in the prior art, claim 8 has been canceled to facilitate allowance of the present

application. Applicants reserve the right to pursue the subject matter of this claim in a future application.

B. Claim 9

Claim 9 depends from claim 7, and recites amino acids 475-483 of UL26. Dilella does not teach or suggest this particular region of UL26, and it would not be obvious to one of skill in the art to select amino acids 475-483 of UL26, in particular, for use as an immunogenic polypeptide.

C. Claims 10-11

Claims 10 and 11 are directed to fusion proteins of the polypeptide recited in claim 7. At page 3 of the Office Action, it is stated that "since the claim 9 is directed to any fusion protein having 475-483 of SEQ ID NO: 9 the fusion protein does read on large portion of polypeptide as disclosed by Dilella et al. having the same 15mer." This statement is in error in two ways. First, claim 9 is not directed to fusion proteins. It is therefore presumed that the Examiner intended to refer to claim 10, which is directed to fusion proteins. Second, the fusion protein of claim 10 does not read on the polypeptides disclosed by Dilella.

The specification defines fusion proteins at paragraph 0071, on page 28, as "a polypeptide of the present invention together with an unrelated immunogenic protein." It appears the Examiner is construing claim 10 to read on a large fragment of UL26, allegedly taught by Dilella, that would inadvertently contain amino acids 475-483. Such a molecule would not be regarded as a fusion protein, based on either the definition provided in the specification or on what is considered a fusion protein by those of ordinary skill in the art. For example, the *Oxford Dictionary of Biochemistry and Molecular Biology*, Oxford University Press, 1997, defines a "fusion protein" as "an expression product resulting from the fusion of two genes." No such molecule, containing the expression product resulting from the fusion of: (1) a gene encoding up to 15 amino acids of an HSV polypeptide comprising amino acids 475-483 of UL26, and (2) another gene, such as an unrelated immunogenic protein; is taught or suggested by the prior art.

Accordingly, Applicants maintain that the subject matter of claims 8-11 is novel and nonobvious over the prior art, and respectfully request withdrawal of the prior art rejections.

VI. CONCLUSION

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP
Attorneys for Applicant(s)

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date: November 4, 2005

By: 

Name: Karen S. Canady
Reg. No.: 39,927

KSC/